

Application No.: 10/606911

Case No.: 55313US010

Remarks

Claims 1 to 20 are pending. Claims 1 to 11 have been withdrawn from consideration. No claims have been amended. Claims 21 to 26 have been added.

§ 112 & § 101 Rejections

Claim 15 stands rejected under 35 USC § 112, first paragraph and 35 USC § 101; as not being supported by an asserted utility.

Applicants have amended the specification to recite that another embodiment of the invention involves partially tearing the carrier along a plurality of discontinuities during the step of applying the adhesive surface of the sheeting to the vehicle. Support for this amendment exists by virtue of claim 15 being present in the application as originally filed. In the original application, claim 15 was present as claim 45.

Applicants submit that by reciting that the step of partially tearing is another embodiment of the invention, they have provided an adequate written description of claim 15 under 35 USC § 112, first paragraph and a utility therefore under 35 USC § 101.

Applicants submit that the rejection of claim 15 under 35 USC § 112, second paragraph and 35 USC § 101, has been overcome, and that the rejection of claim 15 on these grounds should be withdrawn.

§ 103 Rejections

Claims 12-14, 16, 18 and 19 stand rejected under 35 USC § 103(a) as being unpatentable over Olsen (U.S. 5,916,399) in view of Orensteen (U.S. 5,706,133).

Claims 17 and 20 stand rejected under 35 USC § 103(a) as being unpatentable over Olsen in view of Orensteen further in view of Bacon (U.S. 6,508,559).

With respect to claims 12-14, 16, 18 and 19 the Examiner argues that it would be obvious to feed the material of Olsen in roll form as shown in Orensteen. The Examiner's basis for this combination is her contention that the use of a roll of articles adhered to a sheet is a well known method of transferring flexible articles to be a substrate as shown in Orensteen. She further contends that even though Olsen does not show protecting the adhesive, it would have been

Application No.: 10/606911

Case No.: 55313US010

obvious to protect the adhesive of Olsen with the carrier of Olsen. Applicants traverse this rejection.

First, Olsen nowhere teaches or suggests that it would be appropriate to use a "roll" process to transfer graphics from a carrier to a substrate. In fact, Olsen is silent with regard to the use of rolls in the process. Olsen only teaches the use of a flat sheet transfer process. See col. 6, lines 5-34, especially lines 17-21. See also col. 8, lines 7-14.

Second, Orensteen is concerned with the transfer of a thermally transferable colorant to a retroreflective surface. Thus it is only concerned with adding a colored image of one sort or another to a retroreflective surface. Orensteen is not concerned with, and nowhere suggests, the application of a retroreflective segment to a substrate.

When these factors are considered it is clear that there is no motivation in Orensteen either reference to combine their teachings.

The combination of Olsen and Orensteen does not render claims 12-14, 16, 18 and 19 unpatentable for another reason. The combination proposed by the Examiner would provide a method for applying graphic images to the retroreflective surface of Olsen. Thus, it would not result in the claimed invention.

With respect to the rejections of claims 13, 14, 16, 18 and 19 similar reasoning applies. The references relied upon by the Examiner are not properly combined.

Additionally, with respect to claim 18, the term "conspicuity" does not mean "eye catching and has the quality or state of being attracting attention ..." Conspicuity, as defined in the present invention and as understood in the art, means the improving the nighttime visibility of articles (page 1, lines 14-15). Simply making something eye catching or attracting attention does not provide improved nighttime visibility. It is also noted that neither Olsen nor Orensteen say anything about conspicuity. Consequently, the Examiner's assertion regarding eye catching or attracting attention can provide no basis for a rejection of claim 18.

It is believed that the rejection of claims 12-14, 16, 18 and 19 under 35 USC § 103(a) has been overcome and should be withdrawn.

The rejection of claims 17 and 20 over Olsen in view of Orensteen further in view of Bacon is also traversed. As noted above, the combination of Olsen with Orensteen is improper. The addition of Bacon does nothing to cure the problem.

Application No.: 10/606911

Case No.: 55313US010

Bacon is only offered for the proposition that shows the use of an extensible carrier web. However, since the basic combination fails to support the rejection, the substitution of a different carrier cannot support the rejection.

It is believed that the rejection of claims 17 and 20 under 35 USC § 103(a) has been overcome and should be withdrawn.

New claims 21-26 are each independently patentable. For example, in claim 21 the article is provided in the form of a roll. As discussed above this is not obvious in view of the cited references. Additionally, the carrier used in the roll has a first major release surface. This is not taught or suggested in either reference. Claim 22 adds the feature that exposing the adhesive surface comprises unrolling the roll. This is a feature not taught in either reference. Claims 23-26, each dependent from claim 21, are also patentable because of the additional features they add in addition to being dependent from claim 21.

In summary, the rejection of claims 12-20 under 35 USC § 103 has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

Date June 8, 2004

By: James V. Lilly
James V. Lilly, Reg. No.: 77,817
Telephone No.: (651) 733-1543

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833